UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

BDP INTERNATIONAL, INC.,	
Plaintiff,	
v.	**No. 17-3308**
BDP INTERNATIONAL ENTERPRISES INC. and BRANDON PENNINGTON	**JURY TRIAL DEMANDED**
Defendants.	

COMPLAINT

Plaintiff BDP International, Inc. ("BDP International" or "Plaintiff"), by and through its attorneys, Fox Rothschild LLP, brings this action against Defendants BDP International Enterprises Inc. ("BDP Enterprises") and Brandon Pennington ("Pennington") (collectively "Defendants") and states and alleges as follows:

PRELIMINARY STATEMENT

1. Plaintiff is a Philadelphia-based global entity offering high quality business consultation and management services in the transportation, shipping and logistics fields for over forty years under the BDP and BDP INTERNATIONAL brand names. As a result of the billions of dollars in revenue earned from services rendered and the goodwill generated in the transportation, shipping and logistics industries, the BDP brands are highly valued trademarks of Plaintiff, and the subject of Federal Trademark Registrations for the marks BDP and BDP INTERNATIONAL, INC. (the "BDP Marks"). Plaintiff recently learned that Defendants have begun the unauthorized sale/rendering and/or offer for sale of similar and/or competing services

bearing the names BDP and BDP INTERNATIONAL ENTERPRISES INC. via an online establishment at www.bdpinternationalenterprises.com, with offices located in this District. This unauthorized and unlawful use of these names will create or likely create confusion and mistake among customers and clients in the industry. Accordingly, Plaintiff seeks judicial intervention to stop the Defendants' unauthorized and unlawful use of these infringing names.

JURISDICTION AND VENUE

2. Pursuant to 15 U.S.C. § 1121(a), this Court has original subject matter jurisdiction over this action as it arises under U.S.C. Title 15, Chapter 22 ("Lanham Act"), and involves Defendants' infringement of the federally registered and common law trademarks owned by Plaintiff, and Defendants' false designation of origin under 15 U.S.C. §1125(a).

3. Pursuant to 28 U.S.C. §§ 1331 and 1338, this Court has original jurisdiction over claims asserted under the Lanham Act, as these claims arise under the federal laws of the United States. Additionally, this Court has supplemental jurisdiction over all other claims not asserted under the Lanham Act pursuant to 28 U.S.C. § 1367(a), as these claims are related to claims within the Court's original jurisdiction.

4. This Court has personal jurisdiction over Defendants because: (1) Defendants transact and solicit business in this District; (2) Defendant BDP Enterprises is an Illinois corporation registered to do business in this District; (3) Defendant Pennington is a resident of the State of Illinois with an address within this District; and (4) Defendants sell/render and/or offer for sale, within or without this State, services that infringe Plaintiff's trademarks expecting their acts to have consequences in this District.

5. Venue is proper in this District under 28 U.S.C. §§ 1391(b), and 1391(c) in that Defendants reside in or can be found in this District, the claims arose in this District, and the Defendants are subject to personal jurisdiction in this District.

THE PARTIES

6. Plaintiff BDP International, Inc. is a Pennsylvania corporation, and having its principal place of business at 510 Walnut Street, 13th Floor, Philadelphia, PA 19106, with an office located within this District at 855 Busse Road, Bensenville, Illinois 60106.

7. Defendant BDP International Enterprises Inc. is, upon information and belief, an Illinois corporation (although not presently in good standing with the State of Illinois), having a business address of 15729 Centennial Drive, Orland Park, Illinois 60462.

8. Defendant Brandon Pennington is, upon information and belief, an Illinois resident, having an address at P.O. Box 358, Bloomingdale, Illinois 60108.

FACTS COMMON TO ALL CLAIMS

Plaintiff's Business

9. Since at least as early as 1972, Plaintiff has provided a broad variety of services in the United States and internationally. Plaintiff's wholly owned operations, joint ventures and/or affiliates are located in 140 countries spanning more than 270 offices.

10. Plaintiff offers a full range of business services in the transport, shipping and logistics fields, import-export logistics, regulatory/trade compliance, customs clearance, warehousing and distribution, process improvement, supply chain optimization and many consulting, informational and operation-related services related to the foregoing (the "BDP International Services").

11. Plaintiff renders services to customers/clients across all industries, public and private, some being the largest US and worldwide corporations offering consumer products, textiles, pharmaceuticals, chemical, oil and gas.

12. Since first opening in 1972, Plaintiff has grown in size, now employing over 1400 people in North America, with over two dozen locations in the United States, including an office within this District located in Bensenville, Illinois. *See* https://www.bdpinternational.com/global-locations/global-locator/.

13. Since first adoption, the BDP brand has consistently stood for high quality and dependable services in the shipping/transportation logistics industries. Plaintiff has experienced a tremendous amount of growth over the past four decades, resulting in excess of $100 million in revenue annually in the United States, with over $500,000 spent on marketing and advertising annually.

14. BDP-branded services are advertised, marketed, and rendered throughout the United States and within this District.

15. The BDP International Services are also advertised and marketed via Plaintiff's online website located at www.bdpinternational.com wherein the company, its service offerings, and its locations are also identified (the "BDP International Website").

16. As a result of Plaintiff's quality-driven service offerings, its expertise and knowledge in the global logistics field and its longtime use of the BDP Marks, the BDP and BDP INTERNATIONAL brands have developed a local, national and international prominence and reputation.

17. Through Plaintiff's continuous and exclusive use of the BDP Marks in the rendering of the BDP International Services, as well as its extensive advertisement/marketing

efforts, Plaintiff's BDP Marks have acquired such considerable goodwill that the public has come to associate these marks exclusively with Plaintiff and to believe that the BDP Marks uniquely identify Plaintiff's high quality services.

The BDP Trademark Registrations

18. BDP International, realizing that the value of its BDP brands were significantly tied to its identification with the public and needing to secure protection on a national basis, nearly 20 years ago filed for, and successfully secured, federal trademark registrations for the BDP Marks.

19. Specifically, on May 27, 1998, Plaintiff filed for federal trademark protection of the BDP mark under Section 1(a) of the Trademark Act of 1946, as amended ("Lanham Act"), 15 U.S.C. § 1051(a). The BDP mark was granted registration on the United States Patent and Trademark Office's ("USPTO's") Principal Register on December 21, 1999 as Registration No. 2,301,666 for services described as "management assistance, namely, assisting in management of transportation, warehousing and distribution information and logistics; business consultation in the field of supply chain process analysis; management assistance, namely, determining logistics of construction projects" and "transport brokerage, namely, transport brokerage, namely, custom house brokerage and freight forwarding services; surface and air freight transportation services, transportation of goods by ocean, rail, truck and air" and "reviewing standards and practices to assure compliance with import and export laws and regulations."

20. The foregoing Registration remains in good standing, due to the November 30, 2009 filing and December 3, 2009 acceptance of a combined Declaration of Continued Use and Renewal of Registration (for 10 Years) with the USPTO. As such, this mark is valid,

subsisting and incontestable. True and correct copies of U.S. Registration No. 2,301,666 for BDP and the Notice of Acceptance of Renewal are attached hereto as **Exhibit 1**.

21. Plaintiff is also the owner of U.S. Trademark Registration No. 2,295,420 for the trademark "BDP INTERNATIONAL, INC." covering services described as "management assistance, namely, assisting in the management of transportation, warehousing and distribution information and logistics, and determining logistics of construction projects; and business consultation in the field of supply chain process analysis" and "transport brokerage, namely, custom house brokerage; freight forwarding services; surface and air freight transportation services; and transportation of goods by ocean, rail, truck, and air" and "reviewing standards and practices to assure compliance with import and export laws and regulations," registered on the USPTO Principal Register on November 30, 1999.

22. The foregoing Registration remains in good standing, due to the November 30, 2009 filing and December 3, 2009 acceptance of a combined Declaration of Continued Use and Registration (for 10 Years) with the USPTO. As such, the BDP INTERNATIONAL, INC. mark is valid, subsisting and incontestable. True and correct copies of U.S. Registration No. 2,295,420 for BDP INTERNATIONAL, INC. and the Notice of Acceptance of Renewal are attached hereto as **Exhibit 2**. The BDP and BDP INTERNATIONAL, INC. Trademark Registrations are hereinafter referred to as the "BDP Registrations."

Defendants' Competing Services

23. Upon information and belief, Defendant BDP Enterprises is an Illinois Corporation formed in April 2016, by its purported owner, Defendant Pennington.

24. Upon information and belief, Defendant Pennington is also the registrant and purported owner of the domain name www.bdpinternationalenterprises.com (the "BDP Enterprises Domain Name").

25. Upon information and belief, Defendants are the owners of the *bdpinternationalenterprises.com* domain name (the "BDP Enterprises Website").

26. Content hosted on the BDP Enterprises Website features, in large, prominent, bold, letters across the top, the wording BDP followed by the wording INTERNATIONAL ENTERPRISES, INC. in smaller faded font as set forth below.

27. Defendants' BDP Enterprises Website promotes four categories of service offerings: strategic planning; risk management; expert analysis (including supply chain management and employee compensation); and industry best practices (including manufacturing and service industries).

28. Upon information and belief, Defendants began offering and/or rendering the foregoing services in the United States, in the State of Illinois, and within this District, branded as BDP and/or BDP INTERNATIONAL ENTERPRISES, INC. in 2016, wherein the services are marketed to customers/clients directly via the BDP Enterprises Website.

Defendants' Infringement of Plaintiff's Registered Trademarks

29. From 1972 until the present, Plaintiff BDP International has enjoyed significant success and acclaim, in the promotion and sale/rendering of its BDP International

Services. The BDP International Services are offered/promoted via the BDP International Website and rendered by Plaintiff and/or its wholly owned subsidiaries and affiliates under the BDP and BDP INTERNATIONAL, INC. trademarks across the United States and in over 140 countries worldwide.

30. Despite such use and accompanying federal trademark registrations, with both actual and constructive knowledge of Plaintiff's BDP Marks and BDP Registrations, in April 2016, Defendant Pennington formed and incorporated a legal entity in the State of Illinois under the name BDP International Enterprises Inc.

31. Subsequently, with both actual and constructive knowledge of Plaintiff's BDP Marks and BDP Registrations, in May 2016, Defendant Pennington personally registered the domain name www.bdpinterntionalenteprises.com via domain name registrar GoDaddy.com, LLC.

32. Upon information and belief, shortly thereafter, with both actual and constructive knowledge of Plaintiff's BDP Marks and BDP Registrations, Defendants launched the BDP Enterprises Website hosted at the BDP Enterprises Domain Name.

33. Today both BDP International and BDP Enterprises employ identical BDP names/trademarks, appearing at the BDP International Website and the BDP Enterprises Website. Representative samples of the trademarks in use on the respective websites appear below:

34. Defendants' BDP INTERNATIONAL ENTERPRISES name and *bdpinternationalenterprises.com* domain name fully incorporate Plaintiff's registered BDP and BDP INTERNATIONAL trademarks.

35. The BDP Enterprises Website promotes service offerings listed as "expert analysis" of "supply chain management."

36. The BDP Registrations cover services identified as "business consultation in the field of supply chain process analysis."

37. Plaintiff promotes these same services via the BDP International Website, at https://www.bdpinternational.com/services/lead-logistics-provider/, specifically:

> There is no substitute for a logistics partner with a proven track record. The right industry expertise. The commitment to provide exceptional value and service. To help you meet the increasing complexity and challenges within your supply chain.
>
> ***
>
> Complete visibility of every step in your supply chain. Industry leading transportation management tools ensure complete control, visibility and transparency of all your shipments.

38. The foregoing services identified in the BDP International Registrations and on the BDP International Website are identical to those services identified on the BDP Enterprises Website.

39. Upon information and belief, Defendants' BDP Enterprises business is purportedly located in Bloomingdale, Illinois, with an address at PO Box 358, Bloomingdale, Illinois, while Plaintiff maintains offices in the neighboring town of Bensenville at 855 Busse Road, Bensenville, Illinois—just over eight (8) miles away and thus, marketing to, and visible to customers in the same geographic territory.

40. In addition to the proximity of geographic locations identified herein, Defendants BDP Enterprises and Plaintiff offer and market their competing services on websites appearing at nearly identical domain names: www.bdpinternational.com (Plaintiff) and www.bdpinternationalenterprises.com (Defendants).

41. Both Plaintiff's and Defendants' supply chain analysis services are marketed to the same type of customers, looking for valuable and creative solutions to improve supply chain processes.

42. Defendants' use of the BDP INTERNATIONAL wording is confusingly similar to Plaintiff's BDP International Marks, as Defendants offer identical and/or related supply chain services, offered for sale without Plaintiff's authorization or authorization from any other person or entity authorized to grant such permission.

43. Defendants' use of the BDP INTERNATIONAL name is confusingly similar to Plaintiff's BDP Marks, and is likely to cause consumers to believe that Plaintiff's and Defendants' services originate from the same source or are somehow related, or that Plaintiff is licensing, endorsing, authorizing, sponsoring or is in some way associated with Defendants' activities.

44. Defendants' use of names that are confusingly similar to Plaintiff's BDP Marks will adversely interfere and continue to adversely interfere with Plaintiff's efforts to market and advertise the BDP branded goods in this District.

45. Defendants are capitalizing on Plaintiff's well-known goodwill and reputation to enhance the promotion and sales of their own goods for commercial purposes and financial gain.

46. Plaintiff has been and continues to be injured by Defendants' unlawful acts within the State of Illinois and within this District.

47. Defendants acted with actual and constructive notice of the BDP Registrations and of Plaintiff's extensive and continuous use of the BDP Marks well prior to its adoption of the competing BDP INTERNATIONAL ENTERPRISES, INC., name/mark in association with supply chain analysis and related services.

48. In fact, in addition to constructive notice of the BDP Registrations, as registered with the United States Patent and Trademark Office, on March 16, 2017, Plaintiff sent a demand letter to Defendant BDP Enterprises, requesting cessation of all use of the BDP and BDP INTERNATIONAL names.

49. In response, Defendants have resorted to public protestations on their website, erroneous explanations of trademark law, and an acknowledgment of confusion by such statements posted on their website, including:

> We do not intentionally mean to confuse you or anyone else with a different and distinguished business name that is registered with their local state of authority. It is your responsibility to distinguish business names. More importantly, BDP INTERNATIONAL ENTERPRISES, INC. is not responsible for your confusion of the names of businesses' or your decision(s) based on your confusion.

A true and correct copy of the BDP Enterprises Website page at http://www.bdpinternationalenterprises.com/complaint-publication-03-17-2017-06-35-55.html is attached hereto as **Exhibit 3.**

50. Despite both actual and constructive knowledge of Plaintiff's BDP Marks and BDP Registrations, on March 20, 2017, and in response to Plaintiff's demand letter of March 16, 2017, Defendants have announced an intent to further expand their use of the infringing BDP

Enterprises names via the launch of a private business and vocational school within this District. Specifically:

> We are announcing that we are currently planning to open a Private Business and Vocational School in Bloomingdale, IL 60108. This private university will study current issues of Chicago and Aerospace Engineering and Transportation with the help of BDP INTERNATIONAL ENTERPRISES, INC. This future institution will be the cutting edge to learning and education! Please donate to our cause via the following link at GoFundMe.

A true and correct copy of the BDP Enterprises Website page at http://www.bdpinternationalenterprises.com/plans-to-open-pbvs-in-bloomingdale--il-14-28-01.html is attached hereto as **Exhibit 4.**

51. Thus, Defendants performed the acts complained of herein (both before and after contact by Plaintiff) willfully and with knowledge of the infringement they would cause, and with intent to cause confusion, mistake, or deception, and to appropriate and unfairly trade upon Plaintiff's extensive reputation and goodwill in the BDP Marks.

CAUSES OF ACTION

COUNT I
AGAINST BOTH DEFENDANTS
FEDERAL TRADEMARK INFRINGEMENT UNDER 15 U.S.C. §§ 1114, 1117

52. Plaintiff repeats, realleges and incorporates all of the allegations made in paragraphs 1 through 51 of this Complaint as if fully set forth herein.

53. Defendants' unauthorized and unlicensed use of the BDP and BDP INTERNATIONAL ENTERPRISES, INC. names is confusingly similar to the BDP and BDP INTERNATIONAL, INC. trademarks in United States commerce in association with services related to the advertising, marketing, promotion, offer for sale and sale/rendering of services, including but not limited to "expert analysis" in the field of "supply chain management" is likely

to cause confusion and mistake and to deceive consumers as to the source or origin of Defendants' services.

54. Defendants' acts infringe upon Plaintiff's BDP and BDP INTERNATIONAL, INC. trademarks, with consequent damage to Plaintiff and Plaintiff's business and goodwill symbolized by the BDP and BDP INTERNATIONAL, INC. trademarks in violation of 15 U.S.C. § 1114 (Section 32 of the Lanham Act).

55. Defendants' acts of infringement of the BDP and BDP INTERNATIONAL, INC. trademarks for commercial purposes and financial gain have caused and are causing great and irreparable injury to Plaintiff, to the BDP and BDP INTERNATIONAL, INC. trademark, and to Plaintiff's business and goodwill represented by these BDP Marks, in an amount that cannot be ascertained at this time, and, unless enjoined, will cause further irreparable injury, leaving Plaintiff with no adequate remedy at law.

56. Defendants' acts have been willful, deliberate, and intended to benefit Defendants at Plaintiff's expense.

57. By reason of the foregoing, Plaintiff is entitled to injunctive relief against Defendants, and, after trial, to recover any damages proven to have been caused by reason of Defendants' acts of trademark infringement.

COUNT II
AGAINST BOTH DEFENDANTS
FALSE DESIGNATION OF ORIGIN UNDER 15 U.S.C. §1125(a)

58. Plaintiff repeats, re-alleges and incorporates all of the allegations made in paragraphs 1 through 57 of this Complaint as if fully set forth herein.

59. Defendants' use of names which are confusingly similar to the BDP Marks in the manner described above are likely to cause consumers to mistakenly believe that Defendants

have an affiliation with the Plaintiff, that Defendants' services are sponsored or approved by Plaintiff, or that Defendants are otherwise associated with or have obtained permission from Plaintiff.

60. Defendants' acts of unfair competition and false advertising have caused and are causing great and irreparable injury to Plaintiff, to the BDP Marks, and to the Plaintiff's business and goodwill represented by these trademarks in an amount that cannot be ascertained at this time and, unless enjoined, will cause further irreparable injury, leaving Plaintiff with no adequate remedy at law.

61. By reason of the foregoing, Plaintiff is entitled to injunctive relief against Defendants, and, after trial, to recover any damages proven to have been caused by Defendants' acts of unfair competition and false designation of origin.

COUNT III
AGAINST BOTH DEFENDANTS
TRADEMARK INFRINGEMENT UNDER ILLINOIS STATE LAW

62. Plaintiff repeats, re-alleges and incorporates all of the allegations made in paragraphs 1 through 61 of this Complaint as if fully set forth herein.

63. The acts of Defendants as described above constitute trademark infringement in violation of Plaintiff's rights under the common law of the State of Illinois and the Illinois Trademark Registration and Protection Act, 765 ILCS 1036/65 *et seq*.

COUNT IV
AGAINST BOTH DEFENDANTS
UNFAIR COMPETITION AND DECEPTIVE TRADE PRACTICES
UNDER ILLINOIS STATE LAW

64. Plaintiff repeats, re-alleges and incorporates all of the allegations made in paragraphs 1 through 63 of this Complaint as if fully set forth herein.

65. The acts of Defendants as described above constitute deceptive trade practices in violation of 815 ILCS 510/1 *et seq*. and unfair competition and unfair or deceptive acts or practices under 815 ILCS § 505/1 *et seq*.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff respectfully requests this Court to enter judgment in its favor as follows:

1. Declare that Defendants' unauthorized conduct violates Plaintiff's rights under the Lanham Act, the common law of Illinois, and the Illinois Compiled Statutes.

2. Immediately and permanently enjoin Defendants, their agents, servants, employees, representatives, attorneys, related companies, successors, assigns, and all others in active concert or participation with Defendants from:

(a) using the "BDP" name or trademark or any confusingly similar variations of BDP or any designations that include the term BDP for any supply chain and/or business consultation-related services and any other services identical and/or related to the BDP International Services;

(b) from doing any other acts or things calculated or likely to cause confusion or mistake in the mind of the public, or to lead consumers into the belief that the goods and/or services marketed, advertised, promoted, offered for sale, and/or rendered by Defendants are authorized, sponsored, licensed, endorsed, promoted, or condoned by Plaintiff, or are otherwise affiliated with or connected to Plaintiff;

(c) representing by any means whatsoever, directly or indirectly, that any goods and/or services offered or rendered/sold by Defendants are offered, rendered by, or approved by Plaintiff, or from otherwise taking any action likely to cause confusion, mistake, or deception on the part of consumers as to the origin or sponsorship of such goods;

(d) otherwise competing unfairly with Plaintiff in any manner;

(e) continuing to perform in any manner whatsoever any of the other unlawful acts complained of in this Complaint; and

(f) aiding any other party in doing any acts prohibited by this paragraph.

3. Direct Defendants to discontinue use of the domain name *bdpinternationalenteprises.com* or any other confusingly similar variations of this domain, including any designations that consist of or include the term BDP INTERNATIONAL.

4. Direct Defendants to provide a complete accounting of their infringing activities and to deliver to Plaintiff any and all marketing materials in Defendants' possession, custody or control, displaying a trademark confusingly similar to Plaintiff's BDP Marks.

5. Order Defendants, pursuant to 15 U.S.C. § 1116, to serve on Plaintiff within thirty (30) days after service on Defendants of preliminary or permanent injunction orders, a report in writing, under oath, setting forth in detail the manner and form in which Defendants have complied with the injunction(s).

6. Order Defendants to account to Plaintiff for Defendants' profits and any damages sustained by Plaintiff arising from Defendants' acts of trademark infringement, and unfair competition, and order that Plaintiff be awarded the greater of (i) three times Defendants' profits or (ii) three times any damages sustained by Plaintiff under 15 U.S.C. § 1117, plus prejudgment and post-judgment interest.

7. Award Plaintiff its costs and disbursements incurred in connection with this action, including reasonable attorneys' fees, investigative expenses, and expert and other fees, on the ground that this is an exceptional case under 15 U.S.C. § 1117.

8. Award Plaintiff such other and further relief as the Court deems just and proper.

DEMAND FOR JURY TRIAL

Pursuant to Rule 38(b) of the Federal Rules of Civil Procedure, Plaintiff hereby demands a trial by jury on all triable issues contained in the Complaint.

Dated: May 2, 2017

Respectfully submitted,

FOX ROTHSCHILD LLP

/s/ Joseph E. Collins

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